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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/534,083	05/05/2005	Erkki Reuhkala	915-003.022	2390
4955 7590 12/13/2007 WARE FRESSOLA VAN DER SLUYS & ADOLPHSON, LLP BRADFORD GREEN, BUILDING 5 755 MAIN STREET, P O BOX 224 MONROE, CT 06468			EXAMINER TORRES, MARCOS L	
			ART UNIT 2617	PAPER NUMBER
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

**Application No.**

10/534,083

**Applicant(s)**

REUHKALA ET AL.

**Examiner**

Marcos L. Torres

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 25 September 1975.
- 2a) ☒ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-29 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 May 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Response to Arguments***

1. Applicant's arguments filed 9-25-07 have been fully considered but they are not persuasive.
2. The examiner appreciates the amendment to claim 23. However, in claim 1 applicant is claiming a method while in claim 23 the applicant is claiming a computer readable medium which is distinct from claim 1. Since a dependent claim must contain all the limitations of its parent claim, claim 23 is still a method claim but applicant is claiming a computer readable medium, thereby creating a hybrid claim.
3. As to applicant arguments that Denisson does not disclose providing a terminal with location dependent routing information stored in a data storage; Denisson discloses providing the terminal with information regarding the neighboring systems which are used to route calls when the device is located in their boundary (see col. 11. lines 59-65; col. 12, lines 6-17), thereby Denisson does disclose the above limitation. Moreover at least for claim 1, this claim recite "providing a terminal" instead of transferring to a terminal like claim 24, the provision can be done directly by sending the information or indirectly by providing the device with the information during a service.
4. Regarding applicant arguments that Denisson is not provided with any location dependent routing information, as shown above Denisson discloses providing the terminal with information regarding the neighboring systems which are used to route calls when the device is located in their boundary (see col. 11. lines 59-65; col. 12, lines 6-17), thereby Denisson does disclose the above limitation.

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5. As to applicant arguments that Denisson cannot control the routing of the terminal based on location, the selection of the system is directly related to the boundaries of the system and the location of the terminal as recited by Denisson boundary (see col. 11. lines 59-65; col. 12, lines 6-17),

6. Regarding applicant arguments that Denisson does not receiveh any location dependent routing information, as shown above Denisson discloses providing the terminal with information regarding the neighboring systems which are used to route calls when the device is located in their boundary (see col. 11. lines 59-65; col. 12, lines 6-17), thereby Denisson does disclose the above limitation.

7. As to applicant arguments that Denisson network cannot transmit location dependent routing information from the server to the terminal, as previously disclosed the actual system used based on the location is part of the routing information and Denisson discloses transmitting to the terminal which system to use based on the location of the device (see col. 11. lines 59-65; col. 12, lines 6-17),

8. Regarding applicant arguments that Silver fails to disclose storing location dependent routing information in a data storage and providing the terminal with the data; Silver disclose storing location dependent routing information in a data storage (see abstract; col. 8, lines 8-35) and providing the terminal with the data so the user can change it or update it (see col. 5, line 65 – col. 6 , line 2).

9. The rest of the arguments fall together for the same reasons as shown above.

The current rejection in record stands.

***Information Disclosure Statement***

10. The information disclosure statement (IDS) filed on 5-5-2005 and 1-30-2006 are being considered by the examiner.

***Claim Objections***

11. Claim 23 is objected to because of the following informalities: this claim is directed to a computer program, but the independent claim that refers to is a method claim. It is unclear if claim 23 is directed to a method or a computer program.

Appropriate correction is required.

***Claim Rejections - 35 USC § 102***

12. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

13. Claims 1-2, 7-12, 15, 17-19, 21, 23-25 and 28-29 are rejected under 35 U.S.C. 102(e) as being anticipated by Denisson US006847822B1.

As to claim 1, Denisson discloses a method comprising: storing location dependent routing information in a data storage (see col. 11, lines 55-59); providing a terminal with location dependent routing information stored in the data storage (see col. 11, lines 59-65; col. 12, lines 6-21); and establishing a connection between the terminal and at least one other terminal using location dependent routing information provided by

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the data storage, wherein at least one of the terminals is a mobile terminal and information for routing the connection between the terminals is selected based on the location of the at least one mobile terminal (see col. 12, lines 6-39).

As to claim 2, Denisson discloses a method wherein said establishing the connection comprises initiating the connection establishment by the at least one mobile terminal (see col. 12, lines 6-39).

As to claim 7, Denisson discloses a method wherein a cost of the connection is optimized based on the location dependent routing information (see col. 15, line 65 – col. 16, line 12).

As to claim 8, Denisson discloses a method comprising the further updating the location dependent routing information in response to an event (see col. 12, lines 6-39; see col. 15, line 65 – col. 16, line 12).

As to claim 9, Denisson discloses a method wherein updating is triggered by predetermined change in location of the mobile terminal (see col. 12, lines 6-39; see col. 15, line 65 – col. 16, line 12).

As to claim 10, Denisson discloses a method wherein said establishing the connection comprising routing the connection via a first communication network serving the calling terminal, a second communication network serving the called terminal and a third communication network (see col. 12, lines 6-39; col. 15, lines 3-19; col. 16, lines 12-44).

As to claim 11, Denisson discloses a method wherein said routing comprises routing the connection via an access point entity interfacing the third communication

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network with at least one of the first and second communication networks (see col. 12, lines 6-39; col. 15, lines 3-19; col. 16, lines 12-44).

As to claim 12, Denisson discloses a method further comprising selecting the access point entity based on the location of the mobile station (see col. 12, lines 6-39; col. 15, lines 3-19; col. 16, lines 4-44).

As to claim 15, Denisson discloses a method wherein the data storage is provided in a routing server, said providing a terminal with location dependent routing information comprising said transmitting the location dependent routing information to the terminal (see col. 9, lines 40-55).

As to claim 17, Denisson discloses a method comprising determining the location of the mobile terminal based on an indicator received from a communication network serving the mobile terminal (see col. 9, lines 55-65).

As to claim 18, Denisson discloses a method determining the location of the mobile terminal based on information regarding the geographical location of the mobile terminal (see col. 9, lines 55-65).

As to claim 19, Denisson discloses a method further comprising computing at least one additional set of location dependent routing information based on location dependent routing information stored in the data storage and a master set of routing information (see col. 12, lines 4-39; col. 13, lines 30-53).

As to claim 21, Denisson discloses a method wherein a calling terminal automatically uses location dependent routing information for establishing connections (see col. 12, lines 4-25).

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Regarding claim 23 is rejected for the same reasons as shown above in claim 1.

As to claim 24, Denisson discloses apparatus comprising a plurality of communication networks for providing a terminal with information for establishing a connection to at least one other terminal (see col. 12, lines 13-21), the arrangement comprising: a data storage for storing location dependent routing information (see col. 11, lines 55-59); for transferring location dependent information from the data storage to the terminal (see col. 11, lines 59-65; col. 12, lines 6-17; col. 9, lines 42-44); and in the terminal, for establishing a connection between the terminal and at least one other terminal using location dependent routing information provided by the data storage, wherein at least one of the terminals is a mobile terminal and information for routing the connection between the terminals is selected based on the location of the at least one mobile terminal (see col. 11, line 49 - col. 12, line 39).

As to claim 25, Denisson discloses a mobile terminal (see col. 15, lines 11-19) comprising: input for input of location dependent routing information for use in establishing a connection over the communication system; and connection establishment for initiating establishment of a connection to another terminal based on the location dependent routing information (see col. 11, line 49 - col. 12, line 39).

As to claim 28, Denisson discloses a mobile terminal wherein the connection establishment device is configured to automatically use location dependent routing information if available (see col. 12, lines 4-39).

As to claim 29, Denisson discloses a routing server configured to store location dependent routing information, to receive information of the location of a mobile station,



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to modify the location dependent routing information based on the location of the mobile station and to transmit location dependent routing information to terminals.

14. Claims 1, 3, 10, 13-14, 20, 22 and 24-25 are rejected under 35 U.S.C. 102(e) as being anticipated by Silver US007162237B1.

As to claim 1, Silver discloses a method for providing routing information for establishing connections over a communication system comprising a plurality of communication networks (see fig. 3, items 308, 102, 320) the method comprising: storing location dependent routing information in a data storage (see fig. 1, item 108, 110, 112, 112); providing a terminal with location dependent routing information stored in the data storage; and establishing connection between the terminal and at least one other terminal using location dependent routing information provided by the data storage, wherein at least one of the terminals is a mobile terminal and information for routing the connection between the terminals is selected based on the location of the at least one mobile terminal (see abstract; col. 8, lines 8-35).

As to claim 3, Silver discloses a method wherein said establishing the connection comprises initiating the connection establishment by a terminal other than the at least one mobile terminal (see col. 8, lines 8-35).

As to claim 10, Silver discloses a method wherein said establishing the connection comprising routing the connection via a first communication network serving the calling terminal, a second communication network serving the called terminal and a third communication network (see fig. 3, items 308, 102, 320).

As to claim 13, Silver discloses a method wherein the third communication network comprises a packet switched data network (see col.2, lines 53-67).

As to claim 14, Silver discloses a method comprising wherein communication of data over said data network is based on the Internet Protocol (see col.2, lines 53-67).

As to claim 20, Silver discloses a method further comprising the steps of inputting in the terminal a telephone number of the other terminal, and routing the connection between the terminals based on the location dependent routing information (see col. 8, line 22 – col. 9, line 13).

As to claim 22, Silver discloses a method wherein one of the terminals is a computer, said establishing a connection comprising establishing a data connection between the at least one mobile terminal and the computer (see col. 6, lines 33-37).

Regarding claim 24 is the respective system claim of method claim 1. Therefore, claim 24 is rejected for the same reasons as shown above.

Regarding claim 25 is the respective device claim of method claim 1. Therefore, claim 25 is rejected for the same reasons as shown above.

***Claim Rejections - 35 USC § 103***

15. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

16. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

17. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

18. Claims 4-5, and 26-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Denisson in view of Blakeney US006085085A.

As to claim 4, Denisson discloses the method comprising the further selecting information from one of the sets of routing information based on the location of the mobile terminal (see col. 11, line 49 - col. 12, line 39). Denisson does not specifically disclose storing at least two sets of location dependent routing information in the mobile terminal. In an analogous art, Blakeney discloses storing at least two sets of location dependent routing information in the mobile terminal (see col. 4, lines 11-39). Therefore,

it would have been obvious to one of the ordinary skill in the art at the time of the invention to also save the location dependent information to enable the mobile terminal to acquire the most desirable system and thereby the most desirable routing, cost and quality of service.

As to claim 5, Blakeney discloses a method wherein the at least two sets of location dependent routing information comprise sets of routing information for use in the home network and in at least one visited network (see col. 4, lines 11-54).

As to claim 26, Denisson discloses a method mobile terminal comprising processor for processing information associated with the location of the mobile terminal (see col. 12, lines 6-39) and Blakeney discloses a mobile terminal configured to select routing information for connection establishment based on the location thereof (see col. 4, lines 11-54).

Regarding claim 27 is the respective device claim of method claim 4. Therefore, claim 27 is rejected for the same reasons as shown above.

19. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Denisson in view of Silver.

As to claim 16, Denisson discloses everything as explained above (see claim 15) except for the method further comprising initiating a procedure for connection establishment by sending a voice command from the terminal to the routing server. In an analogous art, Silver discloses the method further comprising initiating a procedure for connection establishment by sending a voice command from the terminal to the routing server (see col. 8, lines 20-37). Therefore, it would have been obvious to one of

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the ordinary skill in the art at the time of the invention to use voice recognition to facilitate user input for the activation of the features.

20. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Denisson in view of Blakeney as applied to claim 5 above, and further in view of Mazzarella US006819921B2.

As to claim 6, Denisson discloses everything as explained above (see claim 5) except for the method comprising the further receiving by the mobile terminal in a roaming situation the set of routing information relating to the visited network in which the mobile station is roaming. In an analogous art, Mazzarella discloses the method comprising the further receiving by the mobile terminal in a roaming situation the set of routing information relating to the visited network in which the mobile station is roaming (see col. 2, lines 39-45). Therefore, it would have been obvious to one of the ordinary skill in the art at the time of the invention to send the configuration data to the mobile terminal to enable the terminal to use the visited network.

### ***Conclusion***

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marcos L. Torres whose telephone number is 571-272-7926. The examiner can normally be reached on 8:00am-6:00 PM alt. Wednesday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, George Eng can be reached on 571-252-7495. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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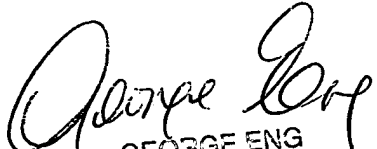
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SUPERVISORY PATENT EXAMINER